

Application No. 09/696,754

Attorney Docket No.: 26119-136C US1

REMARKS/ARGUMENTS

In the Office Action, the Examiner noted that Claims 1-10, 12, 59-67 and 76-87 are pending in the above-identified patent application, that claims 76-87 have been withdrawn from consideration, and that claims 1-10, 12 and 59-67 are rejected. By this Amendment, Claim 1 has been amended and claims 88-89 have been added. In addition, Applicant respectfully traverses the new restriction requirement. Accordingly, Claims 1-10, 12, 59-67 and 76-89 are pending in the application. Reconsideration is respectfully requested.

Election With Traverse

Applicant elects claims 1-10, 12 and 59-67 with traverse.

Claims 76-87 have been withdrawn from consideration as being directed to a separate or distinct invention. Applicant respectfully traverses this requirement. Specifically, the Examiner states that restriction is proper "for the following reasons: Claim 1 does not include features of documents, contractual keyword descriptors, and updated values. Conversely, claim 76 does not include the limitation of "business language definition descriptors that specify the descriptive metadata of each of the information bundles."

Applicant disagrees with these statements by the Examiner. Specifically, Claim 1 does include, in combination, "portion of said content attribute descriptors including **business language definition descriptors** that specify the descriptive metadata of each of the information bundles" and by virtue of dependency, Claims 59-62, recite **business language descriptors, keywords, descriptors and values**:

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Claim 59 (Previously Presented): The method of claim 1 wherein a different portion from the portion of said content attribute **descriptors** includes bundle **descriptors**.

Claim 60 (Previously Presented): The method of claim 1 wherein a different portion from the portion of said content attribute **descriptors** includes target **descriptors**.

Claim 61 (Previously Presented): The method of claim 1, wherein said **business language definition descriptors** comprise **keywords**, said keywords having at least one **value**.

Claim 62 (Previously Presented): The method of claim 61, wherein said **keywords** comprise at least one of Sector, Ticker, Region, Country, Author, Firm, and Bundle Type.

In addition, Claim 76 does include, in combination,

"wherein the bundle header comprises:

bundle target descriptors that specify which of the second plurality of networked users have authorization to access the bundle; and

business language descriptors that specify the descriptive metadata of the bundle using keywords that are standardized through an agreement, wherein the business language descriptors have associated values."

Accordingly, Applicant respectfully submits that the Examiner's reasoning is incorrect, and therefore, **restriction is not proper**. For example, the Commissioner/Director has stated in an analogous situation the following in *Ex parte Alminana*, 1902 C.D. 293, 100 O.G. 1331, 1331(Comm'r Pat. 1902):

Claims 1 and 2 are drawn specifically to an umbilical truss structure. Claims 3, 4, and 5 are not so limited; but they nevertheless cover the unitary structure of this invention. The device described and claimed in this application is a single invention, and

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there does not appear to be a clear line of division between the broad claims 3, 4, and 5 and the specific claims 1 and 2. The requirement of division should not be insisted upon. Accordingly, for these reasons as well, Applicant respectfully traverses the restriction requirement, and urges the Examiner to withdraw same and examine claims 76-87.

Rejection of the Claims Under 35 U.S.C. § 103

Claims 1, 2, 3, 5-10, 12, 59-63 and 65-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowman U.S. Patent No. 6,601,234 ("Bowman-'234"). The Examiner also cites Official Notice (which Applicant hereby traverses as described below), and Milsted et al. U.S. Patent No. 6,345,256 ("Milsted"); **however, neither of these references is cited in the rejection.** Accordingly, **for this reason alone**, Applicant submits that additional clarification is required for the above rejections to be proper.

Claims 1, 4, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowman-'234 in further view of Milsted et al. U.S. Patent No. 6,345,256 ("Milsted") and U.S. Patent 6,625,643 to Colby et al ("Colby").

Applicants respectfully traverse these rejections.

In particular, the Bowman prior art reference describes creating a stream that contains message data and metadata and using a message language to read the formatting information and metadata off of the stream. Contrary to the Examiner's contentions, the Examiner has failed to

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show where business language definition descriptors that specify the descriptive metadata of each of the information bundles is shown in the Bowman prior art reference.

In addition, the Bowman reference does not show or suggest "deriving traffic statistics for the step of distributing based on values for the content attribute descriptors." The Examiner cites a portion of Bowman that merely states that "attribute values may be obtained for auditing or rollback purposes" (Bowman-'234, column 200, lines 43-44). However, the Examiner has not pointed out that the Bowman reference shows that traffic statistics are derived based on the values for the content attribute descriptors.

Accordingly, without conceding that Bowman '234 shows or suggests any of the elements of the present invention, Bowman-'234 does not show or suggest "distributing information bundles . . . according to a machine-readable format that includes values for a plurality of content attribute descriptors, a portion of said content attribute descriptors including business language definition descriptors that specify the descriptive metadata of each of the information bundles" or "deriving traffic statistics for the step of distributing based on values for the content attribute descriptors," as recited in combination with the remaining elements of independent claim 1.

In rejecting independent claim 1, the Examiner cites portions of Bowman-'234 that merely disclose data of message sent from a sending system to a receiving system, where the data is translated based on metadata. In particular, the Bowman reference describes creating a stream that contains message data and metadata and using a message language to read the

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formatting information and metadata off of the stream. Contrary to the Examiner's contentions, the Examiner has failed to show where business language definition descriptors that specify the descriptive metadata of each of the information bundles are shown in the Bowman reference.

The Examiner admits that Bowman-'234 does not disclose deriving traffic statistics for the step of distributing based on values for the content attribute descriptors. Rather, the Examiner states that "[i]t is deemed an obvious variant of auditing to derive traffic statistics since that is what auditing is." Applicant respectfully submits that this **reasoning is circular**, and therefore, the Examiner has **not provided a prima facie case of obviousness**.

In addition, Applicant also disagrees that it is an obvious variant of auditing to derive traffic statistics with respect to the claimed combination. Applicant requests the Examiner to provide a prior art reference describing this allegedly well known feature in the context of the present invention or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicant requests withdrawal of this rejection. In addition, the Examiner states in connection with claim 65 that Official Notice is taken regarding the standard format of bundles. Applicant also requests the Examiner to provide an affidavit or prior art reference, since Applicant does not believe that the present invention utilizes a standard format of bundles.

Accordingly, as described above, Bowman-'234 does not show or suggest at least "distributing information bundles . . . according to a machine-readable format that includes values for a plurality of content attribute descriptors, a portion of said content attribute

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descriptors including business language definition descriptors that specify the descriptive metadata of each of the information bundles" or "deriving traffic statistics for the step of distributing based on values for the content attribute descriptors," as recited in combination with the remaining elements of independent claim 1.

With respect to the rejection of claims 1-3, 5-10, 12, 59-63 and 65-69, the Examiner cites on page 3 of the Office Action, Milsted et al., U.S. Patent 6,345,256, entitled "Automated method and apparatus to package digital content for electronic distribution **using the identity of the source content**" but does not utilize Milstead in this obviousness rejection. However, even assuming Milstead et al. was applied, which Applicant requests clarification to fully address this prior art reference, Milstead et al. is not related to the present invention, but relates to a method of automatically retrieving data associated with content. An identifier is read that is stored on electronic readable medium storing content.

In Milsted et al., Clearinghouse 105 keeps a record of all transactions and can report them to responsible parties, such as Electronic Digital Content Store 103 and Content Provider 101, on an immediate, periodic, or restricted basis. This reporting is a means by which Content Provider 101 can be informed of the sale of Content 113 and the Electronic Digital Content Store 103 can obtain an audit trail of electronic delivery to their customers. The Clearinghouse 105 can also notify the Content Provider 101 and/or Electronic Digital Content Store 103 if it detects that information in a SC has been compromised or does not comply with the Content's Usage Conditions. The transaction recording and repository capabilities of the Clearinghouse 105 database is structured for data mining and report generation. Accordingly, Applicant disagrees

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with the Examiner that combining Bowman '234 and Milstead et al. results in the presently claimed invention. Withdrawal of this rejection is respectfully requested.

In addition, the Examiner states in connection with Claims 66 and 67, that what the statistics are used for is an intended use. Applicant respectfully disagrees. The Manual of Patent Examining Procedure (MPEP) specifically states at Section 2173.05(g), copy enclosed, the following:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. . . .

A functional limitation must be evaluated and considered, like any other limitation of the claim, for what it conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

In addition, the Federal Circuit has confirmed that data is to be provided patentable weight over the prior art. For example, the data structure in *In re Lowry*¹ involved the storage, use, and management of information. The invention provided an efficient, flexible method of organizing stored data in a computer, with a data structure accessible by many different application programs. The data structure was stored in memory and represented complex information in terms of attributes and relationships between attributes.

Claim 1, which was representative of the data structure, recited as follows:

A memory for storing data for access by an application program being executed on a data processing system, comprising:

¹*In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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a data structure stored in said memory, said data structure including information resident in a database used by said application program and including:

a plurality of attribute data objects stored in said memory, each of said attribute data objects containing different information from said database;

a single holder attribute data object for each of said attribute data objects, . . . each of said attribute data objects having a being-held relationship with only a single other attribute data object, thereby establishing a hierarchy of said plurality of attribute data objects;

a referent attribute data object for at least one of said attribute data objects, said referent attribute data object being nonhierarchically related to a holder attribute data object for the same at least one of said attribute data objects . . . ; and

an apex data object stored in said memory and having no being-held relationship with any of said attribute data objects. . . .²

The Patent Office rejected the claims as obvious in view of the prior art. In formulating the rejection, the Patent Office did not find a sufficient functional relationship between the data structure and the memory to afford patentable weight to the data structure itself.³ Rather, the Patent Office considered the invention to be merely a memory storing information and did not provide the data any patentable weight.

On appeal, the Federal Circuit reversed. The Federal Circuit first emphasized the narrow application of the printed matter doctrine, noting that the doctrine typically applies to inventions having novel arrangements of printed lines or characters, useful and intelligible only to the human mind.⁴ In this connection, the court stated that "the Board erroneously extended a printed matter rejection under sections 102 and 103 to a new field in this case, which involves

²*Id.*, 32 USPQ2d at 1033.

³See *supra* §III.B (regarding the functional relationship requirement and inventions related to printed matter).

⁴*In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031, 1034 (citing *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (C.C.P.A. 1969)).

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information stored in a memory.”⁵ In holding that the data structure should be afforded patentable weight, the Federal Circuit stated:

More than a mere abstraction, the data structures are specific electrical or magnetic structural elements in a memory. . . . In short, Lowry’s data structures are physical entities that provide increased efficiency in computer operation. They are not analogous to printed matter. **The Board is not at liberty to ignore such limitations.**⁶

Thus, *Lowry* held that the data structures are to be provided patentable weight. Therefore, with respect to all claims, as well as claims 66 and 67, Applicant requests the Examiner to withdraw the rejections.

Claims 1, 4, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowman-’234 in further view of Milsted et al. U.S. Patent No. 6,345,256 (“Milsted”) and U.S. Patent 6,625,643 to Colby et al (“Colby”).

Applicant traverses this rejection.

Colby et al., U.S. Patent 6,625,643, entitled “System and method for resource management on a data network” relates to a broadcast manager that automatically commits resources and sets up network interconnections to produce a broadcast session on a data network.

The Examiner has not provided any clear guidance why one would have combined the Bowman, Milsted et al. and Colby et al. references, and even if combined, how the proposed combination results in the claimed invention. Colby et al. appears wholly irrelevant to the present invention.

⁵*Id.*
⁶*Id.*, 32 USPQ2d at 1035.

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As described above, Bowman and Milsted et al. do not show or suggest the claimed features. In addition, as described above, Colby et al. does not provide any of the deficiencies of Bowman and Milsted et al. Accordingly, for these reasons as well, Applicant requests withdrawal of the above rejection, and such action is earnestly requested.

Thus, for at least the reasons set forth above, neither Bowman-'234, Milstead et al. nor Colby et al. show or suggest all the claimed feature of Applicants' invention claimed in amended independent claim 1. Therefore, Applicants respectfully submit that independent claim 1 and dependent claims 2-10, 12, and 59-67, which depend from independent claim 1, are allowable over the prior art of record. Accordingly, Applicants request that the rejection of the claims should be withdrawn.

In addition, new claims 88-89 are also submitted to be patentably distinguishable over Bowman '234. For example, without conceding that Bowman '234 shows or suggests any of the elements of the present invention, Bowman-'234 does not show or suggest, for example as recited in claim 89, "information bundles in a machine-readable format, each information bundle in the set of information bundles comprising a set of values for content attribute descriptors and values for information fields characterizing commercial interactions" or "content attribute descriptors comprising business language definition descriptors that specify descriptive metadata relating to the set of information bundles," as recited in combination with the remaining elements of independent claim 89. Accordingly, for these reasons as well, Applicant submits that claims 88-89 are patentably distinguishable over the prior art.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not

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concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

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For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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